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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,315	04/08/2004	Kristina Kershner	31011-1001	9713
5179	7590	09/20/2005	EXAMINER	
PEACOCK MYERS, P.C.			PIERCE, WILLIAM M	
P O BOX 26927			ART UNIT	
ALBUQUERQUE, NM 87125-6927			PAPER NUMBER	
			3711	

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/821,315	Applicant(s) KERSHNER, KRISTINA	
	Examiner William M. Pierce	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

WILLIAM M. PIERCE
PRIMARY EXAMINER

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as set forth in the previous office action and below in response to applicant's remarks.

Claim 1 generally relates to a manipulation of "people" (or sets of persons). In line with MPEP 2105,

"If the broadest reasonable interpretation of the claimed invention as a whole encompasses a human being, then a rejection under 35 U.S.C. 101 must be made indicating that the claimed invention is directed to nonstatutory subject matter."

Applicant has not made a response with respect to this grounds for rejection.

Additionally, would this appear to fall into the category of a manipulation of abstract ideas in how a group should "interact". MPEP 2106 gives a little guidance in that it states.

While a "process" is well recognized as statutory subject matter, not every process falls within the "useful arts" under 101. *Cochrane v. Deener*, 94 U.S. 780, 788 (1877) define "a process is...an act or series of acts, performed upon the subject matter to be transformed and reduced to a different state or thing.

Lastly, the examiner's position is based on the fact that it has been held that the claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. Therein defined limits patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept. (*Brenner v.*

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Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); In re Ziegler, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)).

Applicant has not shown where there exists a “concrete or tangible result or a practical application. In the instant invention the results are intangible. The groups of “persons”, words and generated texts exist the same after the applicant’s process is performed as they did before the process.

Applicant believes his invention meets the standard under 101 as being directed at an “enhanced storytelling and idea generation”. Examiner does not agree since “idea generation” does not fall within 101. An idea inherent unto itself is something intangible. Applicant states that participants come up with stories, ideas and other creative writing forms which are a “tangible use of the game apparatus”. However, the claims fail to recite anything pertaining to “stories” or “writing”. As such this argument is unpersuasive.

Applicant goes on to argue that his method is to enhance “storytelling and idea generation”. However, the claims call for a “group interaction method” rather than a method for storytelling or generating ideas.

Subsequently argued is that a transformation occurs “into written form” and upon the “game apparatus itself”. To the former, the claims do not call for any steps of writing to occur. While the step of “persons record one or more words’ may be to what the applicant refers to as writing. Such steps of recording can occur mentally or by other methods other than writing. As to the latter, the only apparatus mentioned by the claims is “scenario cards”. However, the cards in the claims exist in the same state both before and after the applicants method is performed and experience no useful transformation. As such these arguments are not persuasive.

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With respect to the other patents discussed by applicant, it has been held the other patents cannot be used to show patentability since there is a presumption of validity attributed to each claim of an issued patent.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 6 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Lizzola 4,671,516.

As to claims 1, 6 and 7, Lizzola shows randomly selecting a plurality of indicia (abstract, ln. 3) on the cards that do not have a single letter, requiring a person to generate a sentence containing words (col. 2, ln. 22) and having a second person record words that are likely to be used bny checking “that every word in the sentence is correctly used” (col. 2, ln. 53). As to claims 2, 3 and 5, the cards 10 are used to randomly select a scenario 12.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject

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matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lizzola in view of Penders 3,640,531.

The use of spinners containing concentric rings and cards in randomly selecting indicia in games is considered well known. To have substituted the cards of Lizzola with another known expedient such as a spinner or cards in order to select indicia would have been an obvious matter of choice.

Response to Arguments

Applicant's arguments with respect to claims 1-7 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication and its merits should be directed to William Pierce at E-mail address bill.pierce@USPTO.gov or at telephone number (571) 272-4414.

For **official fax** communications to be officially entered in the application the fax number is (703) 872-9306.

For **informal fax** communications the fax number is (703) 308-7769.

Any inquiry of a general nature or relating to the **status** of this application or proceeding can also be directed to the receptionist whose telephone number is (703) 308-1148.

Any inquiry concerning the **drawings** should be directed to the Drafting Division whose telephone number is (703) 305-8335.



WILLIAM M. PIERCE
PRIMARY EXAMINER